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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,657	12/08/2003	Srikanth Karimisetty	021756-001900US	4952
51206 7590 06/13/2007 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER POWERS, WILLIAM S	
			ART UNIT 2134	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/731,657	Applicant(s) KARIMISSETTY ET AL.	
	Examiner William S. Powers	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/8/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement submitted 12/8/2003 has been considered.

Claim Objections

2. Claims 1, 3, 8, 9 and 16 are objected to because of the following informalities:
 - a. As to claim 1, the limitation "the fields" recited in line 5 of the claim has no antecedent basis.
 - b. As to claim 3, the limitation "the data record" recited in line 2 of the claim has no antecedent basis. For the purpose of examination, the Examiner assumes the limitation to refer to the electronic record.
 - c. As to claims 8 and 16, the limitation "the rule" recited in line 2 of claim 8 and line 3 of claim 16 has no antecedent basis.
 - d. As to claim 9, the limitation "the data record" recited in lines 14-15 of the claim has no antecedent basis. For the purpose of examination, the Examiner assumes the limitation to refer to the electronic record.Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 9 and 17, the terms "allowing" in claim 1, "allow" in claim 9 and "allowing" in claim 17 are unclear and indefinite. It is not clear what the metes and bounds are, since none of the steps recites a positive or active action. The claims do not recite the actual occurrence of an action; just that such an action is possible. Thus, anything that doesn't stop these actions from happening appears to meet the claim limitations.

As to claims 2-8, 10-16 and 18-22, they are rejected based on their dependency from a rejected base claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 17-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 17, the claim is a computer program "per se". The descriptions of the code are not tangible and there are no active actions claimed. The claims "allow" a user to do an action, but there is no positive recitation that any action is taken or executed. Thus, the claim is considered to be directed to non-statutory subject matter.

Claims 18-22 are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3, 5, 8, 9-11, 13, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik.

As to claim 1, Slater teaches:

- a. Allowing a user to define an event that, upon occurrence, generates an electronic record that requires an electronic signature (a document is prepared that requires one or more digital signatures) (Slater, column 7, lines 5-16).
- b. Allowing a user to define the fields stored in the electronic record (document is prepared by the user through inputting data and content into a template and determining the signatures needed for the document) (Slater, column 7, lines 7-13 and column 9, lines 50-63).
- c. Allowing a user to generate a map that maps data from the underlying database tables to at least some of the fields defined for the electronic record (using templates to store documents in databases) (Slater, column 7, lines 5-14).

Slater does not expressly mention the physical layout of the document. However, in an analogous art, Pavlik teaches:

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d. Allowing a user to define a layout for displaying data in the electronic record on a computer display when an electronic signature for the data record is collected (user selects data items to be displayed in the document according to position and orientation within the document) (Pavlik, column 5, lines 43-53 and figure 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater with the user defined layout of Pavlik in order to further customize the document template as illustrated in figures 2 and 3 of Pavlik.

Slater as modified further teaches:

e. Allowing a user to identify a signatory approver for the electronic record (document is signed by one or more persons indicated in the electronic document) (Slater, column 7, lines 15-17).

f. In response to the occurrence of the event (a legal transaction that is to be recorded in a county office) (Slater, column 10, lines 51-55), generating the electronic record (a document is prepared that requires one or more digital signatures) (Slater, column 7, lines 5-14) and displaying the electronic record to the signatory approver according to the defined layout (Slater, column 6, lines 38-40 and Pavlik, column 5, lines 16-21).

g. Receiving an electronic signature from the signatory approver (Slater, column 7, lines 15-25).

h. Associating the electronic signature with the electronic record (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 2, Slater as modified teaches verifying the electronic signature prior to associating the electronic signature with the electronic record (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 3, Slater as modified teaches associating the electronic signature with the electronic record is performed in response to a positive verification of the electronic signature (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 5, Slater as modified teaches verifying the electronic signature and storing the electronic record in a common repository of electronic records that are generated from multiple data sources (once the recorder as verified the signatures the electronic document is stored in a database) (Slater, column 15, lines 17-32 and figure 5).

As to claim 8 as best understood, Slater as modified teaches determining that an electronic signature is required, displaying data from the electronic record on a

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computer display (According to claim 1, only electronic documents that require electronic signatures are generated so that any document generated by the invention requires a digital signature. The document is presented to each of the one or more signatories so that their respective digital signatures can be captured) (Slater, column 7, lines 14-25).

As to claim 9, Slater as modified teaches:

- a. A processor (Slater, column 5, lines 59-67).
- b. A database (Slater, column 15, lines 17-32).
- c. A computer-readable memory coupled to the processor, the computer readable memory configured to store a computer program (Slater, column 6, lines 25-28).

The limitations (i)-(viii) are substantially similar to the limitations of claim 1 and are similarly rejected.

As to claim 10, the limitations of the claim are substantially similar to the limitations of claim 2 and are similarly rejected.

As to claim 11, the limitations of the claim are substantially similar to the limitations of claim 3 and are similarly rejected.

As to claim 13, the limitations of the claim are substantially similar to the limitations of claim 5 and are similarly rejected.

As to claim 16, the limitations of the claim are substantially similar to the limitations of claim 8 and are similarly rejected.

As to claim 17, the limitations of the claim are substantially similar to the limitations of claim 1 and are similarly rejected.

As to claim 18, the limitations of the claim are substantially similar to the limitations of claim 2 and are similarly rejected.

As to claim 20, the limitations of the claim are substantially similar to the limitations of claim 5 and are similarly rejected.

10. Claim 4 and claim 12 and claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik as applied to claim 1 and claim 9 and claim 18 respectively above, and further in view of US Patent No. 5,434,917 to Naccache et al. (hereinafter Naccache).

As to claim 4, Slater as modified does not expressly mention that the digital signature comprises a user id and a password. However, in an analogous art, Naccache teaches the electronic signature comprises a user id and a password (a digital signature scheme that incorporates a user id and password into the computation of a digital signature) (Naccache, column 3, lines 1-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater as modified with the digital signature computation of Naccache in order to establish the identity of user as suggested by Naccache (Naccache, column 3, lines 12-14).

As to claim 12, the limitations of the claim are substantially similar to the limitations of claim 4 and are similarly rejected.

As to claim 19, the limitations of the claim are substantially similar to the limitations of claim 4 and are similarly rejected.

11. Claims 6 and 7 and claims 14 and 15 and claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik as applied to claim 5 and claim 13 and claim 20 above, and further in view of US Patent No. 6,584,459 to Chang et al. (hereinafter Chang).

As to claim 6, Slater as modified does not expressly mention using character large object format. However, in an analogous art, Chang teaches the electronic record comprises unstructured data in a character large object (CLOB) format (storing XML documents in CLOB format) (Chang, column 10, lines 49-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater as modified with the CLOB format storage scheme of Chang in order to store long XML documents as suggested Chang (Chang, column 10, lines 49-62).

As to claim 7, Slater as modified teaches the common repository is a database and wherein the unstructured data is a well-formed XML document stored within a column of a table stored in the database (storage scheme for XML documents in a database) (Chang, column 14, lines 31-35).

As to claim 14, the limitations of the claim are substantially similar to the limitations of claim 6 and are similarly rejected.

As to claim 15, the limitations of the claim are substantially similar to the limitations of claim 7 and are similarly rejected.

As to claim 21, the limitations of the claim are substantially similar to the limitations of claim 6 and are similarly rejected.

As to claim 22, the limitations of the claim are substantially similar to the limitations of claim 7 and are similarly rejected.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,504,818 to Okano teaches a secure document system that requires digital signatures of recipients of electronic documents and customizing the access to portions of the electronic documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



6/5/2007

William S. Powers
Examiner
Art Unit 2134



KAMBIZ ZAND
SUPERVISORY PATENT EXAMINER